

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CARLO AMALFITANO and KEVIN L. FARLEY

Appeal No. 2006-2195
Application No. 09/773,255

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 3, 4 and 8-17.

The disclosed invention pertains to a method and system for queuing far/far service requests in a wireless network.

Representative claim 3 is reproduced as follows:

3. In a wireless communication system in which remote subscriber units are located in cells, and at least two cells are located adjacent one another, each cell having a base station unit that coordinates communication with remote units located within its respective cell, a method comprising the steps of:

- in an operating base station, determining the existence of communications occurring in adjacent cells;
- receiving, by the operating base station, a report of an expected time of low interference communications from an adjacent base station; and
- scheduling transmission of high interference communications associated with a subscriber unit in the cell associated with the operating base station at the expected time of low interference communications in the adjacent cell.

The examiner relies on the following reference:

Dent 5,894,473 Apr. 13, 1999

The following rejection is on appeal before us:

1. Claims 3, 4 and 8-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dent [answer, page 4].

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejection of claims 3, 4 and 8-17. Accordingly, we reverse.

We consider the examiner's rejection of claims 3, 4 and 8-17 as being anticipated by Dent. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 3 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-6, 77 USPQ2d 1321, 1325-6 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson,

169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. Atlas Powder Co. v. Ireco, Inc., 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) citing Titanium Metals Corp. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985).

Appellants acknowledge that Dent teaches coordinating the transmission of cellular signals during allocated time slots using well known "re-use partitioning" techniques wherein the power signals are predetermined and scheduled to be transmitted at known times [brief, page 6]. Appellants argue that Dent does not teach nor suggest transmitting or receiving a report of an expected time of high and/or low interference communications from an adjacent base station [brief, page 7; reply brief, page 4].

The examiner disagrees and points to multiple portions of the Dent reference relied upon in the rejection [answer, page 10]. Specifically, the

examiner asserts that the report is the control information provided by Mobile Switching Center 165 or Base Station 160 where either Mobile Switching Center 165 or Base Station 160 can monitor the signal strength [*id.*]. The examiner notes that Dent's system allows for optimal coordination of high, medium, and low power signals between adjacent base stations as a result of the signal strengths being monitored, sorted, and reordered in real-time or dynamically according to priority (see col. 9, lines 13-19; col. 13, lines 35-48; col. 16, lines 11-16 and 32-64) [*id.*]. The examiner notes that Base Station 160 provides candidate cell information to the mobile unit (see col. 20, line 39 through col. 21, line 6; fig. 12) [*id.*]. The examiner concludes that each base station must have information reported, transmitted, or received from each of the adjacent base stations in order to provide the scheduling of timeslots between low and high interference [*id.*].

We begin by noting that the examiner relies upon three separate sections of Dent as allegedly teaching the limitations disputed by appellants: (a) col. 8, lines 29-37, (b) col. 16, lines 11-15 and 32-64, and (c) col. 20, line 39 through col. 21, line 6 [see answer, page 10]. We agree with appellants that these portions of the Dent reference are concerned with (a) subtractive demodulation techniques [see col. 8, line 3], (b) "re-use partitioning" techniques [see col. 16, line 58], and (c) handover techniques that occur when a mobile phone leaves one cell coverage area and enters

the coverage area of an adjacent cell [see col. 20, lines 63-66]. We further note that the examiner also points to col. 9, lines 13-19 and col. 13, lines 35-48 [answer, page 10] and also col. 9, lines 15-29 and col. 10, lines 20-36 and col. 16, lines 2-5 as providing support for the rejection [answer, page 7].

The examiner argues that the instant claimed report reads on Dent's disclosure of control information provided by Mobile Switching Center 165 or Base Station 160 [answer, page 10]. We note that Dent's only disclosure of control information merely teaches transmission of control information over the control channel of a base station to mobile units locked to that control channel. See col. 20, lines 47-67, cont'd col. 21, lines 1-6:

The base station 160 for a cell includes a plurality of voice channels handled by voice channel transceiver 164 which is controlled by the control and processing unit 162. Also, each base station includes a control channel transceiver 166 which may be capable of handling more than one control channel. The control channel transceiver 166 is controlled by the control and processing unit 162. The control channel transceiver 166 broadcasts control information over the control channel of the base station or cell to mobiles locked to that control channel. This control information can include the OMTs and CFs as described above [emphasis added].

When the mobile 170 first enters the idle mode, it periodically scans the control channels of base stations like base station 160 to determine which cell to lock on or camp to. The mobile 170 receives the absolute and relative information broadcast on a control channel at its voice and control channel transceiver 172. Then, the processing unit 174 evaluates the received control channel information which includes the characteristics of the candidate cells and determines which cell the mobile should lock to. The received control channel information not only includes absolute information concerning the cell with which it is associated, but also contains relative information concerning other cells proximate to the cell with which the control channel is associated. These adjacent cells are periodically scanned while monitoring the primary control channel to determine if there is a more suitable candidate [emphasis added].

After carefully reviewing the multiple sections of the Dent reference relied upon by the examiner, we find that the examiner, as finder of fact, has not fully developed the record so as to clearly show exactly where the disputed limitations are taught within the reference. In particular, we find no specific disclosure within the Dent patent that fairly teaches the step of "receiving, by the operating base station, a report of an expected time of low interference communications from an adjacent base station," as claimed [claim 3, emphasis added].

Therefore, we agree with appellants that the examiner has failed to meet his/her burden of establishing a *prima facie* case of anticipation with respect to representative claim 3 and also with respect to independent claims 8 and 13 that recite essentially equivalent limitations. Accordingly, we will reverse the examiner's rejection of representative claim 3. Because claims 4 and 8-17 stand or fall together with representative claim 3, we will also reverse the examiner's rejection of these claims.

In summary, we will not sustain the examiner's rejection of any claims under appeal. Therefore, the decision of the examiner rejecting claims 3, 4 and 8-17 is reversed.

Whether it would have been obvious to one of ordinary skill in the art at the time of the invention to combine a secondary reference showing communications between adjacent base stations with Dent's use of a central

controller to dynamically adjust frequencies allocated to base stations to minimize interference is a question that is not before us.¹

REVERSED

Jerry Smith

Jerry Smith
Administrative Patent Judge

Howard B. Blankenship

Howard B. Blankenship
Administrative Patent Judge

Jean R. Homere

Jean R. Homere
Administrative Patent Judge

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¹ See Dent, U.S. Pat. 5,844,894, col. 5, lines 1-10, 24-27, col. 10, lines 1-5 and fig. 7.

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